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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,880	08/05/2003	Eric Justin Gould	MNKYP011A	1594

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Silicon Valley IP Group, PC
P.O. Box 721120
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EXAMINER

CARDONE, JASON D

ART UNIT PAPER NUMBER

2142

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,880

Applicant(s)

GOULD, ERIC JUSTIN

Examiner

Jason D Cardone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Attached Office Action.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 2 of USPN 6,633,903 contains every element of claims 1-22 of the instant application and as such anticipates claims 1-22 of the instant application. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egger et al. ("Egger"), USPN 6,233,571, in view of Reed et al. ("Reed"), USPN 6,088,717.

5. Regarding claim 1, Egger discloses a system for searching for and presenting collections of conventional objects, comprising: a computerized system [Egger, col. 3, line 40 - col. 4, line 30 and col. 10, lines 13-65];

a display unit controllable by the computerized system [Egger, col. 11, lines 18-34];

a selection unit influencing what the computerized system depicts with the display unit [Egger, col. 11, lines 35-67];

a meta-folder containing at least one search object for locating instances of the conventional objects in the computerized system [Egger, col. 12, line 40 - col. 13, line 50];

wherein a closed representation of the meta-folder is depictable on the display unit, the closed representation being selectable and open able with the selection unit [ie. closed icon, Egger, col. 29, line 3 - col. 31, line 33 and col. 32, lines 10-21]; and further wherein an open representation of the meta-folder is also depictable on the display unit,

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the open representation of the meta-folder including representations of the instances of the conventional objects [ie. opening an icon, Egger, col. 29, line 3 - col. 31, line 33].

Egger does not specifically disclose a search object for locating current instances of the conventional objects. However, Reed, in the same field of endeavor, discloses updating (locating current instances) of the search object [Reed, col. 8, lines 6-44 and col. 30, lines 14-67]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate updating of data (objects), taught by Reed, in to the database display system, taught by Egger, since Reed suggests transferring of data over a network, similar to the transferring of data over a network disclosed by Egger [Egger, col. 1, lines 15-19 and col. 3, lines 24-30], with automatic updating object versions [Reed, col. 30, lines 14-67]. One of ordinary skill in the art would have been motivated to modify Egger to include the updating of objects, in view of Reed, in order to quicken the information communication.

6. Regarding claim 2, Egger-Reed further discloses the computerized system includes a network, a client device which is connectable to the network, and at least one server which is connectable to the network, such that the client device may access instance of the conventional objects, the search objects, and the meta-folders which are stored on the at least one server [Egger, col. 1, line 23 - col. 2, line 46] [Reed, col. 11, line 66 - col. 12, line 49].

7. Regarding claim 3, Egger-Reed further discloses the network is a global communications network [Egger, col. 3, line 40 - col. 4, line 30] [Reed, col. 12, lines 1-49].
8. Regarding claim 4, Egger-Reed further discloses the client device is a member of the set consisting of personal computers and enhanced devices [Egger, col. 3, line 40 - col. 4, line 30] [Reed, col. 12, lines 1-49].
9. Regarding claim 5, Egger-Reed further discloses the search object is provided as a file and may be freely transferred and stored within the computer system [Egger, col. 29, line 3 - col. 31, line 33] [Reed, col. 12, line 50 - col. 13, line 50].
10. Regarding claim 6, Egger-Reed further discloses the display unit depicts using non-visual representations [Egger, col. 12, line 40 - col. 13, line 50] [Reed, col. 18, lines 19-55].
11. Regarding claim 7, Egger-Reed further discloses the display unit depicts using at least one member of the set consisting of visual, audible, and tactile representations [Egger, col. 12, line 40 - col. 13, line 50] [Reed, col. 18, lines 19-55].
12. Regarding claim 8, Egger-Reed further discloses the selection unit is a user operated input device [Egger, col. 3, line 40 - col. 4, line 30] [Reed, col. 12, lines 1-49].

13. Regarding claim 9, Egger-Reed further discloses the selection unit is an automated process [Egger, col. 29, line 3 - col. 31, line 33] [Reed, col. 30, lines 14-67].

14. Regarding claim 10, Egger-Reed further discloses the meta-folder further includes at least one member of the set consisting of conventional objects and other the meta-folders [Egger, col. 12, line 40 - col. 13, line 50] [Reed, col. 8, line 52 - col. 9, line 29 and col. 16, lines 35-60].

15. Regarding claims 11-22, claims 11-22 have similar limitations as claims 1-10. Therefore, they are rejected under Egger-Reed for the same reasons set forth in the rejection of claims 1-10 [Supra 1-10].

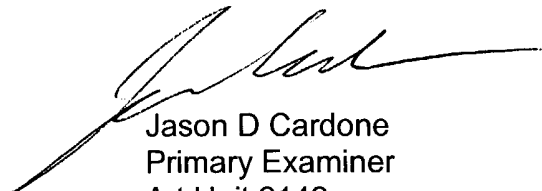
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D Cardone whose telephone number is (703) 305-8484. The examiner can normally be reached on Mon.-Thu. (9AM-6PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone
Primary Examiner
Art Unit 2142

June 10, 2004